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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,936	12/29/2003	Craig L. Ogg	PSTA0002/MRK	7084
29534 7590 09/18/2008 KHORSANDI PATENT LAW GROUP, A.L.C. 140 S. LAKE., SUITE 312 PASADENA, CA 91101-4710				
EXAMINER				
ERB, NATHAN				
ART UNIT		PAPER NUMBER		
3628				
MAIL DATE		DELIVERY MODE		
09/18/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/747,936

Applicant(s)

OGG ET AL.

Examiner

NATHAN ERB

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 20080702
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 2, 2008, has been entered.

Response to Arguments

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Applicants' response to Office action was received on July 2, 2008.
4. In response to Applicants' arguments and amendment of the claims, all of the claim objections from the previous Office action are hereby withdrawn.
5. Please note the new rejections of claim 25 under 35 U.S.C. 112, second paragraph, below in this Office action.
6. In response to Applicants' amendments to claims 8-9, the rejections to claims 8-9 under 35 U.S.C. 101 from the previous Office action are hereby withdrawn. However, note the new rejections under 35 U.S.C. 101 below in this Office action.
7. In response to Applicants' amendment of the claims, the corresponding claim rejections have been correspondingly amended below in this Office action.

8. With respect to Applicants' arguments regarding the prior art rejections, Applicants first argue that the references do not disclose the following claim limitations:

- receiving, from a postal authority, a plurality of mailing subscriber identifiers assigned by the postal authority to the first class mail piece tracking provider;
- identifying from the plurality of mailing subscriber identifiers, a next available mailing subscriber identifier;
- modifying at least one of the next available mailing subscriber identifier and the next available mailing identifier, until determining a combination of a destination tracking service type, the next available mailing subscriber identifier, the next available mailing identifier, and the delivery address identifier corresponding to the delivery address, that would trackably identify the particular first class mail piece during a particular period of time.

Applicants argue that the above limitations are not disclosed in the references because, in the references, there is only one mailing subscriber identifier per subscriber. Examiner has amended the rejections to address this argument. Specifically, Watson has been added to compensate for this deficiency. Watson discloses "wherein a plurality of mailing subscriber identifiers are assigned by the postal authority to a single entity, and identifying from the plurality of mailing subscriber identifiers, a next available mailing subscriber identifier." Therefore, this argument is no longer applicable.

9. Applicants next argue that the prior art references do not disclose serving a user from among a plurality of users. Applicants appear to be using this language to attempt to establish that there is a reselling configuration for tracking codes. However, note that

Montgomery et al. has such a "middleman" configuration. See Montgomery et al., paragraph [0093], which states:

"The centralized postage-issuing computer systems 306 and 307 are also the principal devices that directly transmit tracking ID's to the end user computers 308 over communications links 314 in response to requests by the end user computers 308. This configuration is used when the end user computers 308 do not directly obtain the tracking ID's from the master tracking computer system 310. The centralized postage-issuing computer systems 306 and 307 differ from each other in that the centralized postage-issuing computer system 306 merely acts as a vehicle for passing on tracking ID's issued by the master tracking computer system 310 to the end user computers 308, whereas the centralized postage-issuing computer system 307 actually issues tracking ID's from a previously stored pool of unassigned tracking ID's, which are periodically downloaded from the master tracking computer system 310. In contrast to the centralized postage-issuing computer systems 306/307, the centralized postage-issuing computer system 305 does not take part in the tracking ID issuing process. In this case, it is the master tracking computer system 310, rather than the centralized postage-issuing computer system 305, that transmits tracking ID's to the end user computers 308 over communications links 322 in response to requests by the end user computers 308."

Therefore, one embodiment of Montgomery et al. has tracking ID's being distributed from a master tracking computer system (which is elsewhere noted as being under

control of the postal service) through a centralized postage-issuing computer system (which is elsewhere noted as being under control of the postal vendor). The postal vendor is then a "middleman" for distributing tracking numbers, comparable to Applicants' claims.

It should also be noted that language such as "a particular user of the plurality of users" by itself does not even necessarily invoke a "middleman" configuration. It may simply indicate a plurality of end users. Montgomery et al. discloses serving multiple end users (see Figure 3). Baker et al. also discloses use of its system with multiple end users (see paragraph [0028], which states: "As previously mentioned, the destination CONFIRM service code 400 is currently a barcode wherein the first two digits 410 designate that the PLANET service barcode is being used for destination CONFIRM service, the next first five digits 420 is a unique (and fixed) 5-digit ID assigned by the United States Postal Service to identify mailers subscribed to the PLANET code service offering;" note the use of the plural "mailers"). Therefore, Applicants' arguments are not persuasive with respect to this issue.

10. Applicants' further argue that, where a tracking identifier exists, Montgomery et al. uses that pre-existing tracking identifier as its tracking number, as opposed to generating a new tracking number. It is true that Montgomery et al. discloses this AS AN OPTION; however, Montgomery et al.'s system is NOT LIMITED to that configuration. For example, Montgomery et al., paragraph [0089], states: "If a standard tracking ID 218 is not used on the label 200 (e.g., if the mail piece is being shipped via first class mail), the unique identifier can be composed of the piece count or ascending

register in combination with the postage vendor ID and user account number."

Therefore, Montgomery et al. also discloses an option where new tracking numbers are generated, as the piece count/ascending register increases with each mail piece provided with an indicium.

11. Applicants also argue that the mail piece in Montgomery et al. may only be scanned in a spot-checking fashion, apparently arguing that this would make Montgomery et al. unsuitable for a tracking system. However, note that, even if only some of the mail pieces in Montgomery et al. are tracked, Applicants' tracking system elements (for which Montgomery et al. was used in the rejections) are disclosed with respect to those scanned mail pieces. In addition, note that while spot-scanning is disclosed as an option in Montgomery et al., one-hundred-percent scanning of mail pieces was disclosed as an option as well. See Montgomery et al., paragraph [0032], which states: "For example, during the delivery process for the mail piece, the postal authority can scan all of the postage indicium or simply spot check samples." See also Montgomery et al., paragraph [0137], which states: "Currently, however, the USPS only spot checks the postage indicia, and thus copy fraud may be currently difficult to detect using copy fraud--at least until the USPS scans 100% of the postage indicia."

12. Applicants further argue that, although Montgomery et al. refers to a "tracking ID," Montgomery et al. does not actually provide tracking information. Examiner disagrees. See Montgomery et al., paragraphs [0190]-[0194]. For example, Montgomery et al., paragraphs [0192]-[0193] state:

"At step 1204, the postage transaction information, along with the tracking ID's and associated delivery status, is recorded. Specifically, the database management module 1136 stores the postage transaction information in the postage database 1130. At step 1206, the multitude of mail pieces are processed through the postal authority, which in this case, is the USPS. At step 1208, the postal authority, upon delivery of the mail pieces to their intended destination, reads the tracking ID's on the mail pieces. At step 1210, this delivery information is transmitted to and recorded in the master tracking computer system 390. Specifically, the database management module 1178 updates the confirmatory delivery status information in the tracking information database 1172 by changing the status from "accepted" to "delivered."

At steps 1212 and 1214, the centralized postage-issuing computer system 386 generates and transmits a delivery status request to the master tracking computer system 390."

Montgomery et al., paragraph [0194], further states: "At steps 1222 and 1224, the centralized postage-issuing computer system 386 receives the confirmatory delivery status information from the master tracking computer system 310 and updates the delivery status within the stored postage transaction information with the confirmatory delivery status information." (Keep in mind, again, that, in Montgomery et al., the master tracking computer system is under the control of the postal service, and the centralized postage-issuing computer system is under the control of the postal vendor.) Delivery status information is a form of tracking information because it describes where

a mail piece is located. Therefore, Montgomery et al. explicitly provides tracking information to users, where the users are the postal vendors. As far as the end users, Montgomery et al. does provide tracking information on behalf of, or for the benefit of, end users. For example, the tracking information allows for more convenient postage refunds to end users. See Montgomery et al., paragraphs [0195]-[0197]. Regarding explicitly reporting tracking information to end users, note that Montgomery et al. was not used for the disclosure of such limitations. Rather, Leon is used for such a disclosure (see the prior art rejection for claim 4 below in this Office action). Therefore, Applicants' arguments are not persuasive with respect to this issue.

13. Applicants next argue that the vendor ID in Montgomery et al. cannot be interpreted to be a mailing subscriber identifier, in light of Applicants' specification. Applicants refer Examiner to their specification, p. 10, lines 18-25, which states:

"As briefly previously mentioned above, the exemplary mail piece tracking provider is itself a CONFIRM® Service subscriber. As a CONFIRM® Service subscriber, the exemplary mail piece tracking provider registers with the U.S. Postal Service to obtain one or more subscriber identifiers (subscriber IDs). For non-limiting illustrative purposes only, three (3) exemplary subscriber IDs will be described herein, namely "01", "02" and "03." It will be understood by someone with ordinary skill in the art that more or less subscriber IDs could be used without departing from the spirit of the invention."

However, note that this is an example of a subscriber ID, but subscriber ID is never defined as being limited to a CONFIRM® Service subscriber ID. Therefore, Examiner

was correct in interpreting the term more broadly. When the references are combined in the rejections, the vendor ID is a portion of the tracking identifier that identifies the "middle man," the postal vendor, in the tracking number distribution system. This is functionally the same position that the subscriber identifiers in Applicants' specification are in. Whether called a "vendor ID" or a "mailing subscriber identifier," the identifier is functioning the same.

14. Official Notice Note: If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). MPEP 2144.03 Reliance on Common Knowledge in the Art or "Well Known" Prior Art. In view of applicant's failure to adequately traverse official notice, the following is admitted prior art: "wherein the postage indicium is printed on a first label and wherein the first class mail piece tracking identifier is printed on a second label," "it was well-known to one of ordinary skill in the art at the time of Applicants' invention that tracking information is sometimes placed near the address information in the center of an envelope instead of near the postage indicium in the corner of the envelope," "wherein the postage indicium and the first class mail piece tracking identifier are printed on an envelope," "it was well-known to one of ordinary skill in the art at the time of Applicants' invention that envelopes and labels may each be preferred in different circumstances," "wherein mail pieces are first class mail pieces," and "it was well-known to one of ordinary skill in the art at the time of Applicants' invention that first class is one of the most commonly used classifications of mail."

Claim Rejections - 35 USC § 112

15. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per **Claim 25**, the claim contains an action that is to be performed if a particular condition is present. However, the claim does not also state what action occurs if that particular condition is not present. This renders the claim to be indefinite. The conditional statement being referred to here is: "for a first combination that would not trackably identify the particular first class mail piece during the particular period of time..." The claim language is unclear about what occurs for a first combination that would trackably identify the particular first class mail piece during the particular period of time.

As per **Claim 25**, the claim contains an action that is to be performed if a particular condition is present. However, the claim does not also state what action occurs if that particular condition is not present. This renders the claim to be indefinite. The conditional statement being referred to here is: "if the maximum mailing identifier is exceeded before the combination would trackably identify the particular first class mail piece during a particular period of time..."

Claim Rejections - 35 USC § 101

16. Claims 1, 5-6, 8-9, 13-15, and 23-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1, 5-6, 8-9, 13-15, and 23-25 are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes should positively recite the other statutory class to which they are tied (e.g., by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). Claims 1, 5-6, 8-9, 13-15, and 23-25 identify neither the apparatus performing the recited steps nor any transformation of underlying materials, and accordingly are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

17. Claims 10-12 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Montgomery et al., U.S. Patent Application Publication No. US 2003/0101143 A1

As per **Claim 10**, Montgomery et al. discloses:

- a method of encoding a trackable first class mail piece identifier as a graphic symbology (Figures 19 and 22; paragraph [0032]; paragraphs [0087]-[0088]; paragraph

[0089]; paragraphs [0090]-[0093]; ID is a tracking ID; does not exclude envelope mail; tracking numbers may be added to first class mail in the future; invention may be applied to first class mail pieces);

- receiving a request by a particular user of a plurality of users of a computer-based postage provider to print computer-based postage for a particular first class mail piece for mailing the particular first class mail piece to a particular delivery address (Figures 19 and 22; paragraph [0089]; paragraphs [0090]-[0093]; users request postal indicia from postal vendors; invention may be applied to first class mail pieces);

- assigning a tracking identifier to correspond to the particular user and to trackably correspond to the particular first class mail piece, wherein the tracking identifier trackably identifies the particular first class mail piece during a particular period of time, wherein the tracking identifier comprises a mailing subscriber identifier corresponding to the computer-based postage provider, a mailing identifier, and a delivery address identifier, wherein the delivery address identifier is trackably unique within a combination of the mailing subscriber identifier and the mailing identifier during a period of time, and wherein the mailing subscriber identifier corresponds to an authorization by the postal authority for tracking first class mailings by the computer-based postage provider (Figures 19 and 22; paragraph [0004]; paragraphs [0024]-[0025]; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; invention may be applied to first class mail pieces; mailing subscriber identifier is vendor ID; ID is a tracking ID; mailing identifier is user account number plus piece count [or ascending register]; vendor ID plus user account number plus piece

count [or ascending register] is to be unique over a period of time, thereby allowing tracking; may include POSTNET bar code, which identifies delivery address);

- encoding the tracking identifier as a graphic symbology (Figure 19);
- saving in a memory storage a relationship between the tracking identifier and the particular user (paragraph [0089]; paragraphs [0190]-[0194]; user account number that is part of the tracking ID identifies a particular user).

As per **Claim 11**, Montgomery et al. further discloses said method further comprising: relating the tracking identifier to the user (paragraph [0089]; paragraphs [0090]-[0093]).

As per **Claim 12**, Montgomery et al. further discloses wherein encoding the tracking identifier as a graphic symbology comprises encoding the tracking identifier as a machine-readable bar code (Figure 19; paragraphs [0087]-[0088]; paragraph [0089]; paragraph [0146]).

As per **Claim 18**, Montgomery et al. discloses:

- a method using a computer-based postage system for printing a trackable first class mail piece identifier for a first class mail piece (Figures 19 and 22; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; ID is a tracking ID; does not exclude envelope mail; tracking numbers may be added to first

class mail in the future; invention may be applied to first class mail pieces; system uses computers);

- printing computer-based postage indicia for a particular first class mail piece in accordance with a postage printing request by a particular user of a plurality of users of the computer-based postage system, wherein the postage printing request comprises a delivery address (paragraph [0096]; paragraph [0133]);

- generating a first class mail piece tracking identifier for the particular first class mail piece, wherein the first class mail piece tracking identifier comprises: a mailing subscriber identifier corresponding to an authorization by a governmental postal authority for tracking first class mailings, a mailing identifier, and a delivery address identifier corresponding to the delivery address, wherein the delivery address is trackably unique within a combination of the subscriber identifier and the mailing identifier during a particular period of time (paragraphs [0024]-[0025]; paragraph [0089]; paragraphs [0090]-[0093]; paragraph [0095]; paragraph [0104]; vendor ID [described as possibly part of a "Device ID"] is assigned by USPS; tracking provider is a postal vendor; mailing identifier is user account number plus piece count [or ascending register]; mailing subscriber identifier is vendor ID; vendor ID plus user account number plus piece count [or ascending register] is to be unique over a period of time, thereby allowing tracking);

- storing a set of information relating the first class mail piece tracking identifier to the particular user (paragraph [0089]; paragraphs [0190]-[0194]; user account number that is part of the tracking ID identifies a particular user);

- printing the first class mail piece tracking identifier (Figure 19; paragraphs [0087]-[0088]; paragraph [0089]; paragraph [0146]).

Claim Rejections - 35 USC § 103

18. Claims 1-3, 5, and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al. in view of Baker et al., U.S. Patent Application Publication No. US 2004/0215478 A1, in further view of Watson, Neva, "Changes to the Domestic Mail Manual to Implement Confirm (R) -- Service," 67 FR 53454, August 15, 2002.

As per **Claim 1**, Montgomery et al. discloses:

- a method for a first class mail piece tracking provider to provide, to a plurality of users, tracking of individual outbound first class mail pieces using a computer-based postage system (Figures 19 and 22; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; ID is a tracking ID; does not exclude envelope mail; tracking numbers may be added to first class mail in the future; invention may be applied to first class mail pieces; tracking provider is a postal vendor; system uses computers);

- receiving, from a postal authority, a mailing subscriber identifier assigned by the postal authority to the first class mail piece tracking provider, the mailing subscriber identifier corresponding to an authorization by the postal authority for tracking first class mailings by the first class mail piece tracking provider (Figures 19 and 22; paragraph [0089]; paragraphs [0090]-[0093]; paragraph [0104]; mailing subscriber identifier is

vendor ID; vendor ID [described as possibly part of a "Device ID"] is assigned by USPS; tracking provider is a postal vendor);

- receiving, from a particular user of the plurality of users of the first class mail piece tracking provider, a request to mail a particular first class mail piece to a delivery address, wherein the request from the particular user to mail the particular first class mail piece comprises an indication by the particular user to provide tracking of the particular first class mail piece (Figures 19 and 22; paragraph [0089]; paragraphs [0090]-[0093]; users request postal indicia from postal vendors; postal indicia contain tracking IDs; request is thus at least an implicit indication by user to provide tracking; invention may be applied to first class mail pieces);

- determining a delivery address identifier corresponding to the delivery address (paragraph [0004]; paragraphs [0087]-[0088]; may include POSTNET bar code, which identifies delivery address);

- identifying a next available mailing identifier (paragraphs [0024]-[0025]; paragraph [0089]; paragraphs [0090]-[0093]; mailing identifier is user account number plus piece count [or ascending register]);

- modifying at least one of the next available mailing subscriber identifier and the next available mailing identifier, until determining a combination of a destination tracking service type, the next available mailing subscriber identifier, the next available mailing identifier, and the delivery address identifier corresponding to the delivery address, that would trackably identify the particular first class mail piece during a particular period of time (paragraphs [0024]-[0025]; paragraph [0089]; paragraphs [0090]-[0093]; mailing

identifier is user account number plus piece count [or ascending register]; mailing subscriber identifier is vendor ID; vendor ID plus user account number plus piece count [or ascending register] is to be unique over a period of time, thereby allowing tracking; taking the ascending register would always result in a new unique combination in this new environment, thereby fulfilling this condition and not needing to consider any further combinations);

- assigning a first class mail piece tracking identifier to the particular first class mail piece, wherein the first class mail piece tracking identifier trackably identifies the particular first class mail piece during the particular period of time, and wherein the first class mail piece tracking identifier comprises the next available mailing subscriber identifier, the next available mailing identifier, and the delivery address identifier (Figures 19 and 22; paragraph [0004]; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; invention may be applied to first class mail pieces; mailing subscriber identifier is vendor ID; ID is a tracking ID; mailing identifier is user account number plus piece count [or ascending register]; vendor ID plus user account number plus piece count [or ascending register] is to be unique over a period of time, thereby allowing tracking; may include POSTNET bar code, which identifies delivery address);

- relating the first class mail piece identifier to the particular user of the plurality of users (paragraph [0089]; paragraphs [0090]-[0093]; account number in vendor ID plus user account number plus piece count [or ascending register] relates the mail piece to a user).

Montgomery et al. fails to disclose wherein the tracking identifier includes the destination tracking service type. Baker et al. discloses wherein the tracking identifier includes the destination tracking service type (paragraph [0002]; paragraph [0020]; paragraph [0028]; first two digits of PLANET code is service type). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. such that the tracking identifier includes the destination tracking service type, as disclosed by Baker et al. Motivation is provided by Baker et al. in that the service type indicates whether an origin CONFIRM service or a destination CONFIRM service is desired (paragraph [0002]; paragraph [0020]; paragraph [0028]).

Montgomery et al. and Baker et al. fail to disclose wherein a plurality of mailing subscriber identifiers are assigned by the postal authority to a single entity, and identifying from the plurality of mailing subscriber identifiers, a next available mailing subscriber identifier. Watson discloses wherein a plurality of mailing subscriber identifiers are assigned by the postal authority to a single entity, and identifying from the plurality of mailing subscriber identifiers, a next available mailing subscriber identifier (p. 3, section A; p. 6, section B; p. 9, section C; using a plurality of mailing subscriber identifiers would require that a subscriber be able to choose which one to use for the next destination confirm mailing). Therefore, the prior art included each element claimed although not necessarily in a single reference. One of ordinary skill in the art could have combined the elements as claimed by known methods (this is simply a matter of allowing a vendor in Montgomery et al. to distribute tracking numbers using

more than one different vendor ID; everything would operate the same for different vendor numbers, other than the vendor numbers themselves being different; associating additional vendor IDs with a single vendor can be done simply by adding the additional vendor IDs to a computer file which includes such information about the vendor). In combination, each element merely would have performed the same function as it did separately (again, Montgomery et al.'s tracking system would operate the same for different vendor IDs for the same vendor, with the exception that the vendor IDs themselves would be different; changing the vendor ID would not interfere with being able to indicate the destination tracking service type in the tracking identifier, as in Baker et al.; having multiple vendor/subscriber IDs would still serve the function that they do in Watson, allowing the tracking of more mailpieces). One of ordinary skill in the art would have recognized that the results of the combination were predictable (this is simply substituting one arbitrary ID number in place of another arbitrary ID number, as part of a tracking number; since the vendor numbers themselves could be any values, as long as they are each associated with a single vendor, the system of Montgomery et al. should be expected to function quite the same as vendor IDs are varied for a given vendor). Thus, the combination would have been obvious.

As per **Claim 2**, Montgomery et al. further discloses said method further comprising: encoding the first class mail piece identifier as a graphic symbology; and fixing the first class mail piece identifier graphic symbology in a visual medium (Figure 19).

As per **Claim 3**, Montgomery et al. further discloses said method further comprising: physically associating the first class mail piece identifier graphic symbology fixed in the visual medium with the particular first class mail piece (Figure 19; paragraphs [0087]-[0088]; paragraph [0089]; paragraph [0146]).

As per **Claim 5**, Montgomery et al. fails to disclose wherein the mail piece identifier further comprises: a service type. Baker et al. further discloses wherein the mail piece identifier further comprises: a service type (paragraph [0002]; paragraph [0020]; paragraph [0028]). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. as modified in the rejection for claim 1 such that the mail piece identifier further comprises: a service type, as disclosed by Baker et al. Motivation is provided by Baker et al. in that the service type indicates whether an origin CONFIRM service or a destination CONFIRM service is desired (paragraph [0002]; paragraph [0020]; paragraph [0028]).

As per **Claim 7**, Montgomery et al. further discloses the method further comprising: encoding the first class mail piece identifier as a machine-readable bar code; and printing the machine-readable bar code as a label for the particular first class mail piece (Figure 19; paragraphs [0087]-[0088]; paragraph [0089]; paragraph [0146]).

As per **Claim 8**, Montgomery et al. discloses:

- a method for printably rendering a trackable mail piece identifier graphic symbology (Figure 19; paragraphs [0087]-[0088]; paragraph [0089]; paragraph [0146]);

- encoding a mailing subscriber identifier corresponding to a mailing subscriber identifier assigned by a postal authority to a first class mail piece tracking provider, wherein each mailing subscriber identifier corresponds to an authorization by the postal authority for tracking first class mailings by the first class mail piece tracking provider (Figures 19 and 22; paragraph [0089]; paragraphs [0090]-[0093]; paragraph [0104]; mailing subscriber identifier is vendor ID; vendor ID [described as possibly part of a "Device ID"] is assigned by USPS; tracking provider is a postal vendor);

- encoding a mailing identifier, the encoded mailing identifier comprising an encoding of a mailing identifier corresponding to a particular user of a plurality of users of the first class mail piece tracking provider (Figure 19; paragraphs [0024]-[0025]; paragraph [0089]; paragraphs [0090]-[0093]; mailing identifier is user account number plus piece count [or ascending register]; mailing subscriber identifier is vendor ID; vendor ID plus user account number plus piece count [or ascending register] is to be unique over a period of time, thereby allowing tracking);

- encoding a delivery address identifier corresponding to a delivery address to which the particular user has requested destination tracking of a particular first class mail piece, wherein a combination of the encoded mailing subscriber identifier, the encoded mailing identifier, and the encoded delivery address identifier corresponding to the delivery address, comprises a first class mail piece tracking identifier that trackably identifies the particular first class mail piece during a particular period of time and that is

associated with the particular user (Figures 19 and 22; paragraph [0004]; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; invention may be applied to first class mail pieces; mailing subscriber identifier is vendor ID; ID is a tracking ID; mailing identifier is user account number plus piece count [or ascending register]; vendor ID plus user account number plus piece count [or ascending register] is to be unique over a period of time, thereby allowing tracking; may include POSTNET bar code, which identifies delivery address).

Montgomery et al. fails to disclose encoding a destination tracking service type. Baker et al. discloses encoding a destination tracking service type (paragraph [0002]; paragraph [0020]; paragraph [0028]; first two digits of PLANET code is service type). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. such that it encodes a destination tracking service type, as disclosed by Baker et al. Motivation is provided by Baker et al. in that the service type indicates whether an origin CONFIRM service or a destination CONFIRM service is desired (paragraph [0002]; paragraph [0020]; paragraph [0028]).

Montgomery et al. fails to disclose wherein the tracking identifier includes the encoded destination tracking service type. Baker et al. further discloses wherein the tracking identifier includes the encoded destination tracking service type (paragraph [0002]; paragraph [0020]; paragraph [0028]; first two digits of PLANET code is service type). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. as modified above in this rejection such that the tracking identifier includes the encoded destination tracking

service type, as disclosed by Baker et al. Motivation is provided by Baker et al. in that the service type indicates whether an origin CONFIRM service or a destination CONFIRM service is desired (paragraph [0002]; paragraph [0020]; paragraph [0028]).

Montgomery et al. and Baker et al. fail to disclose wherein a plurality of mailing subscriber identifiers are assigned by the postal authority to a single entity. Watson discloses wherein a plurality of mailing subscriber identifiers are assigned by the postal authority to a single entity (p. 3, section A; p. 6, section B; p. 9, section C; using a plurality of mailing subscriber identifiers would require that a subscriber be able to choose which one to use for the next destination confirm mailing). Therefore, the prior art included each element claimed although not necessarily in a single reference. One of ordinary skill in the art could have combined the elements as claimed by known methods (this is simply a matter of allowing a vendor in Montgomery et al. to distribute tracking numbers using more than one different vendor ID; everything would operate the same for different vendor numbers, other than the vendor numbers themselves being different; associating additional vendor IDs with a single vendor can be done simply by adding the additional vendor IDs to a computer file which includes such information about the vendor). In combination, each element merely would have performed the same function as it did separately (again, Montgomery et al.'s tracking system would operate the same for different vendor IDs for the same vendor, with the exception that the vendor IDs themselves would be different; changing the vendor ID would not interfere with being able to indicate the destination tracking service type in the tracking identifier, as in Baker et al.; having multiple vendor/subscriber IDs would still serve the

function that they do in Watson, allowing the tracking of more mailpieces). One of ordinary skill in the art would have recognized that the results of the combination were predictable (this is simply substituting one arbitrary ID number in place of another arbitrary ID number, as part of a tracking number; since the vendor numbers themselves could be any values, as long as they are each associated with a single vendor, the system of Montgomery et al. should be expected to function quite the same as vendor IDs are varied for a given vendor). Thus, the combination would have been obvious.

As per Claim 9, Montgomery et al. further discloses said method further comprising: wherein the delivery address identifier is trackably unique during a particular period of time, within a combination the encoded mailing subscriber identifier and the encoded mailing identifier (Figures 19 and 22; paragraph [0004]; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]).

Montgomery et al. fails to disclose encoding a service type identifier. Baker et al. further discloses encoding a service type identifier (paragraph [0002]; paragraph [0020]; paragraph [0028]; first two digits of PLANET code is service type). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. as modified in the rejection for claim 8 such that it encodes a service type identifier, as disclosed by Baker et al. Motivation is provided by Baker et al. in that the service type indicates whether an origin CONFIRM service or a

destination CONFIRM service is desired (paragraph [0002]; paragraph [0020]; paragraph [0028]).

19. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al. in view of Baker et al. in further view of Watson in further view of Leon, U.S. Patent No. 7,069,253 B2.

As per Claim 4, Montgomery et al. further discloses said method further comprising: receiving from the postal authority, a plurality of electronic mail piece identifier representations, each electronic mail piece identifier representation of the plurality of electronic mail piece identifier representations corresponding to one scanned first class mail piece identifier of a plurality of scanned first class mail piece identifiers; searching the plurality of electronic mail piece identifier representations for an electronic mail piece identifier that matches the first class mail piece identifier that trackably identifies the particular first class mail piece (Figures 19 and 22; paragraphs [0087]-[0088]; paragraphs [0190]-[0194]).

Montgomery et al., Baker et al., and Watson fail to disclose a postal services vendor receiving from the particular user a request for tracking information regarding the particular first class mail piece and, for an electronic mail piece identifier that matches the first class mail piece identifier that trackably identifies the particular first class mail piece, reporting to the particular user tracking information associated with the electronic mail piece identifier. Leon discloses a postal services vendor receiving from the particular user a request for tracking information regarding the particular first class mail

piece and, for an electronic mail piece identifier that matches the first class mail piece identifier that trackably identifies the particular first class mail piece, reporting to the particular user tracking information associated with the electronic mail piece identifier (Figure 1; column 4, lines 1-55; column 8, lines 21-43; column 14, lines 26-47; column 21, line 19, through column 22, line 30). Therefore, the prior art included each element claimed although not necessarily in a single reference. One of ordinary skill in the art could have combined the elements as claimed by known methods (this is simply allowing an end user mailer to access the tracking information stored in the vendor database of Montgomery et al.; allowing multiple parties access to information in a database was well-known to one of ordinary skill in the art at the time of Applicants' invention). In combination, each element merely would have performed the same function as it did separately (Montgomery et al.'s elements would still be providing a unique tracking identifier to a mail piece; Baker et al.'s element would still allow for the communication of the service type for a mail piece; Watson's element would still allow for the tracking of more mailpieces; Leon's element would still allow a mailer to conveniently access tracking information concerning a mail piece). One of ordinary skill in the art would have recognized that the results of the combination were predictable (simply increasing access to the tracking database does not interfere with the other elements; nor does allowing the end user mailer to access the database in this context lead to any surprising results). Thus, the combination would have been obvious.

20. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al. in view of Baker et al. in further view of Watson in further view of Denman, U.S. Patent No. 5,737,729.

As per **Claim 6**, Montgomery et al., Baker et al., and Watson fail to disclose wherein the delivery address identifier is obtained from Internet-based postage delivery address information. Denman discloses wherein the delivery address identifier is obtained from Internet-based postage delivery address information (column 2, lines 27-45; column 5, lines 15-53; column 6, lines 14-52). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. as modified in the rejection for claim 5 such that the delivery address identifier is obtained from Internet-based postage delivery address information, as disclosed by Denman. Motivation is provided by Denman in that such a configuration allows for address searching (column 2, lines 27-45; column 5, lines 15-53; column 6, lines 14-52).

21. Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al. in view of Baker et al.

As per **Claim 13**, Montgomery et al. discloses:

- a method for tracking individual outbound first class mail pieces (Figures 19 and 22; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; ID is a tracking ID; does not exclude envelope mail; tracking numbers may be

added to first class mail in the future; invention may be applied to first class mail pieces);

- receiving a postage printing request from a particular user of a plurality of users using a computer-based postage provider, said postage printing request comprising a request for computer-based postage indicia for mailing a particular first class mail piece to a delivery address, wherein the request from the particular user to mail the particular first class mail piece comprises an indication by the particular user to provide tracking of the particular first class mail piece (Figures 19 and 22; paragraph [0089]; paragraphs [0090]-[0093]; users request postal indicia from postal vendors; postal indicia contain tracking IDs; request is thus at least an implicit indication by user to provide tracking; invention may be applied to first class mail pieces);

- determining a delivery address identifier corresponding to the delivery address (paragraph [0004]; paragraphs [0087]-[0088]; may include POSTNET bar code, which identifies delivery address);

- formulating a next available first class mail piece identifier for which a combination of a mailing subscriber identifier corresponding to an authorization by a governmental postal authority for tracking first class mailings, the next available first class mail piece identifier, and the delivery address identifier corresponding to the delivery address, would trackably identify the particular first class mail piece during a particular period of time (Figures 19 and 22; paragraph [0004]; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; paragraph [0104]; vendor ID [described as possibly part of a "Device ID"] is assigned by USPS;

invention may be applied to first class mail pieces; mailing subscriber identifier is vendor ID; ID is a tracking ID; mailing identifier is user account number plus piece count [or ascending register]; vendor ID plus user account number plus piece count [or ascending register] is to be unique over a period of time, thereby allowing tracking; may include POSTNET bar code, which identifies delivery address);

- storing an association between the particular user and the combination (paragraph [0089]; paragraphs [0190]-[0194]; user account number that is part of the tracking ID identifies a particular user).

Montgomery et al. fails to disclose wherein the tracking identifier includes the destination tracking service type. Baker et al. discloses wherein the tracking identifier includes the destination tracking service type (paragraph [0002]; paragraph [0020]; paragraph [0028]; first two digits of PLANET code is service type). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. such that the tracking identifier includes the destination tracking service type, as disclosed by Baker et al. Motivation is provided by Baker et al. in that the service type indicates whether an origin CONFIRM service or a destination CONFIRM service is desired (paragraph [0002]; paragraph [0020]; paragraph [0028]).

As per **Claim 14**, Montgomery et al. further discloses said method further comprising: encoding the next available first class mail piece identifier as a graphic symbology (Figure 19).

As per **Claim 15**, Montgomery et al. further discloses wherein the graphic symbology is a one-dimensional bar-code (Figures 20 and 21; paragraph [0146]).

As per **Claim 16**, Montgomery et al. further discloses said method further comprising: printing the graphic symbology (paragraph [0095]).

As per **Claim 17**, Montgomery et al. further discloses said method further comprising: printing computer-based postage indicia in accordance with the postage printing request (paragraph [0133]).

22. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al.

As per **Claim 21**, Montgomery et al. fails to disclose wherein the computer-based postage indicia is printed on a first label and wherein the first class mail piece tracking identifier is printed on a second label. However, that element/limitation was well-known to one of ordinary skill in the art at the time of Applicants' invention (two labels are often used in the corner and center of envelopes, for example). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. such that the computer-based postage indicia is printed on a first label and the first class mail piece tracking identifier is printed on a second label, as was well-known to one of ordinary skill in the art at the time of Applicants'

invention. Motivation is provided in that it was well-known to one of ordinary skill in the art at the time of Applicants' invention that tracking information is sometimes placed near the address information in the center of an envelope instead of near the postage indicium in the corner of the envelope.

As per **Claim 22**, Montgomery et al. fails to disclose wherein the computer-based postage indicia and the first class mail piece tracking identifier are printed on an envelope. However, that element/limitation was well-known to one of ordinary skill in the art at the time of Applicants' invention (postal meters often can print on envelopes or labels). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. such that the computer-based postage indicia and the first class mail piece tracking identifier are printed on an envelope, as was well-known to one of ordinary skill in the art at the time of Applicants' invention. Motivation is provided in that it was well-known to one of ordinary skill in the art at the time of Applicants' invention that envelopes and labels may each be preferred in different circumstances.

23. Claims 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al. in view of Leon.

As per **Claim 23**, Montgomery et al. discloses:

- a method for retrieving a trackable first class mail piece identifier using a computer-based postage system (Figures 19 and 22; paragraph [0032]; paragraphs

[0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; paragraphs [0190]-[0194]; ID is a tracking ID; does not exclude envelope mail; tracking numbers may be added to first class mail in the future; invention may be applied to first class mail pieces; system uses computers);

- retrieving, from a plurality of electronic first class mail piece identifier representations, an electronic first class mail piece identifier representation that matches a particular first class mail piece identifier that trackably identifies a particular first class mail piece during a particular period of time and that corresponds to a particular user of a plurality of users of the computer-based postage system (Figures 19 and 22; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; paragraphs [0190]-[0194]; ID is a tracking ID; does not exclude envelope mail; tracking numbers may be added to first class mail in the future; invention may be applied to first class mail pieces).

Montgomery et al. fails to disclose a postage vendor reporting to the particular user a set of tracking information associated with the electronic first class mail piece identifier representation. Leon discloses a postage vendor reporting to the particular user a set of tracking information associated with the electronic first class mail piece identifier representation (Figure 1; column 4, lines 1-55; column 8, lines 21-43; column 14, lines 26-47; column 21, line 19, through column 22, line 30). Therefore, the prior art included each element claimed although not necessarily in a single reference. One of ordinary skill in the art could have combined the elements as claimed by known methods (this is simply allowing an end user mailer to access the tracking information

stored in the vendor database of Montgomery et al.; allowing multiple parties access to information in a database was well-known to one of ordinary skill in the art at the time of Applicants' invention). In combination, each element merely would have performed the same function as it did separately (Montgomery et al.'s elements would still be providing a unique tracking identifier to a mail piece; Leon's element would still allow a mailer to conveniently access tracking information concerning a mail piece). One of ordinary skill in the art would have recognized that the results of the combination were predictable (simply increasing access to the tracking database does not interfere with the other elements; nor does allowing the end user mailer to access the database in this context lead to any surprising results). Thus, the combination would have been obvious.

24. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baker et al.

As per Claim 24, Baker et al. discloses:

- a method for tracking individual outbound mail pieces using a computer-based postage system (paragraph [0002]; paragraphs [0004]-[0010]; paragraph [0020]; paragraph [0028]);

- assigning a composite confirm identifier to a particular mail piece according to input by a particular mailer of a plurality of mailers that use the computer-based postage system, wherein said composite confirm identifier trackably identifies the particular mail piece during a particular period of time (paragraph [0002]; paragraphs [0004]-[0010]; paragraph [0020]; paragraph [0028]; paragraph [0035]);

- relating the composite confirm identifier for the particular mail piece to the particular mailer (paragraph [0002]; paragraphs [0004]-[0010]; paragraph [0020]; paragraph [0028]);

- receiving a scanning event about the composite confirm identifier scanned by a postal authority (paragraphs [0005]-[0007]; paragraph [0025]);

- reporting the scanning event to the particular mailer (paragraphs [0005]-[0007]; paragraph [0025]).

Baker et al. fails to disclose wherein mail pieces are first class mail pieces. However, that element/limitation was well-known to one of ordinary skill in the art at the time of Applicants' invention (first-class is a very common classification of flat mail). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Baker et al. such that mail pieces are first class mail pieces, as was well-known to one of ordinary skill in the art at the time of Applicants' invention. Motivation is provided in that it was well-known to one of ordinary skill in the art at the time of Applicants' invention that first class is one of the most commonly used classifications of mail.

Conclusion

25. **Examiner's Note:** Examiner has cited particular portions of the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider

the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NATHAN ERB whose telephone number is (571)272-7606. The examiner can normally be reached on Mondays through Fridays, 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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